

*REMARKS*

The Decision on Appeal (Decision) decided June 18, 2010, and the *new* grounds stated therein have been carefully considered. Claims 1, 3, 5-17, 21-24, and 26-33 are presently pending. Claims 2, 4, 18-20 and 25 are canceled. **The Decision affirms the rejection of claims 1, 3, 5-7, 9-17, 21, 23, 24, and 26-33 on new grounds. The Decision reverses the rejection of appealed claims 8 and 22. Because the rejection of the claims is based upon new grounds, Applicants hereby request re-opening the prosecution of the current application under 37 CFR Section 41.50(b)(1).**

Applicants have amended the claims to more clearly define the invention in view of the Decision. In particular, the claims have been modified to unequivocally distinguish an on-line survey solicitation and a subsequently presented on-line survey. The prior art upon which the Decision relies unequivocally records previously presented "surveys" as opposed to "survey solicitations" as recited in the claims. At least this recited element (contained in each of the presently pending independent claims) is not disclosed in the prior art references. For at least this reason a *prima facie* case of obviousness has not been established, and Applicants submit that the claims, as currently presented, are patentable over the prior art.

Accordingly, Applicants request favorable reconsideration of the grounds for the previous rejection of the claims in the Decision. Please charge any fee deficiencies to Deposit Account No. 12-1216.

*Summary of the Grounds for the Rejections*

1. **Claims 1, 3, 5-7, 11-17, 26-27, and 33** are rejected as obvious under 35 U.S.C. §103(a) over de Ment U.S. Pat. No. 6,728,755 (de Ment) in view of Smith et al. U.S. Pub. App. 2002/0128898 (Smith).
2. **Claims 9-10, 21, 23, 24, and 28-32** are rejected as obvious under 35 U.S.C. §103(a) over de Ment in view of Smith and Winn U.S. Pat. No. 6,901,424 (Winn).

**Claims 8 and 22** are deemed allowable by the Decision on Appeal. Applicants traverse each and every ground for rejection of the claims in the Decision, and Applicants request allowance of the presently pending claims in view of the clarifying amendments and at least the reasons set forth herein below.

*Detailed Remarks Responding To The Decision's Grounds for the Rejections**1. Rejection of claims 1, 3, 5-7, 11-17, 26-27, and 33 over de Ment in view of Smith*

The combined teachings of the prior art upon which the Decision relies do not disclose *each of the recited elements* recited within the independent claims 1, 13 and 17. In particular, de Ment and Smith do not disclose, in **claim 1**, at least the following: (1) accessing a timestamp indicating a time period that has passed since an *online survey solicitation* was previously presented; and (2) executing the *additional computer-readable instructions*, if the time stamp indicates sufficient time has passed since a last *online survey solicitation*, to determine whether to present the on-line survey solicitation via the browser. These points of distinction were overlooked by the new grounds for rejecting claims 1, 13 and 17 stated in the Decision.

A *prima facie* case of obviousness requires identification of *each recited claim element* in the prior art. Since the Decision does not identify teachings of each recited element in the cited de Ment and Smith references, a *prima facie* case has not been made with respect to the presently pending independent claim 1. Nor has such a case been established with regard to independent claims 13 and 17 which recite similar claim elements.

Applicants note that the teachings of both de Ment and Smith differ fundamentally from the presently claimed invention. In particular, the claimed invention includes recording the occurrence of an "on-line survey solicitation" on a user's computer. The claimed invention thus facilitates avoiding excessive presentation of *solicitations to take an on-line survey*. On the other hand, both de Ment and Smith disclose recording when a particular *on-line survey* is presented on a computer system. Smith and de Ment disclose recording past presentations of on-line surveys on a particular computer to avoid presenting a same survey to a user multiple times. However, since Smith and de Ment do not record previous presentations of survey *solicitations*, neither Smith nor de Ment provide a way to limit repeated presentations of survey *solicitations* to users that decline previous solicitations to take a survey.

*The recited "issuing" step*

Applicants' claimed "issuing" step is recited as follows:

"issuing, by the user computer in association with processing the received web page, a request to an ad server, for a block of data comprising computer-readable instructions for presenting the on-line advertisement via the browser"

The "issuing" step (corresponding to Step C in FIG. 1 of Applicant's application) arises from the user computer processing a received web page and includes sending a request to an ad server. More particularly, the claimed "issuing" step relates to actions taken by the user computer to obtain a block of data from an ad server comprising instructions for presenting an *on-line advertisement* via the user computer's browser.

Neither de Ment nor Smith discloses a user computer issuing a request to an ad server in association with processing a previously received web page. Instead, Smith, at paragraphs 54-55, 58, 118, 122-125, and 145-146 (cited in the Final Office action) discloses banner ads delivered within the initially downloaded web page. Applicants' interpretation of Smith is bolstered by paragraph [0130] of Smith describing the need to remove the banner from web pages when the survey period ends. In Smith, the banners downloaded in the *initially provided web pages* contain the links to surveys. See also, Smith, paragraph [0058]. There is thus no disclosure in Smith regarding Applicants' claimed issuing, by a user computer, *a request to an ad server in association with processing a previously received web page*.

Moreover, the Decision's reliance on de Ment's disclosure of "any action desired by a designer" does not constitute disclosure of the *specific actions* recited in Applicants' recited "issuing step." See, Decision, page 9, lines 3-8. **In the event the rejection is not withdrawn, Applicants request identification of the specifically recited action of "issuing, by the user computer ... a request to an ad server, for a block of data ... for presenting the on-line advertisement...."**

*The recited "sending" step*

Applicants' claimed "sending" step is recited as follows:

"sending, by the ad server in response to the issued request from the user computer, the block of data including computer-readable instructions for presenting the on-line advertisement and the block of data further including additional computer-readable instructions that facilitate decision-making steps for determining whether to present an on-line survey solicitation via the browser client"

Applicants do not agree with the overly broad interpretation of the term "providing" used by the Decision. However, in view of this broad interpretation, Applicants have replaced the term "providing" by the term "sending" which should clarify the meaning of that claim term.

Applicants' claimed "sending" step identifies particular additional computer-readable instructions contained within the block of data sent by the *ad server* (in response to the "issuing" step arising from the "receiving" step) that facilitate decision-making steps for determining whether to present an on-line survey solicitation. The Decision agrees that Smith did not disclose the recited "providing" (now "sending") step. Instead, the Decision relies upon the teachings of de Ment which describe with reference to step 210 in FIG. 2A a step for determining whether to present a survey invitation to a user. See, Decision, page 9, lines 9-15.

The Decision does not identify any disclosure within Smith or de Ment directed to sending the additional instructions via a block of data *sent by an ad server in response to a request issued by the user computer* (see, "issuing" step discussed above). Therefore, de Ment does not disclose the recited "sending" step – in particular as it relates to the previously discussed "issuing" step. **In the event the rejection of the claim 1 is not withdrawn, Applicants specifically request identification of the claimed "ad server" that sends the claimed "data block" to the user computer.**

*The recited "accessing" step*

Applicants' claimed "accessing" step is recited as follows:

"accessing, on the user computer, a timestamp value indicative of a period of time that has passed since the on-line survey solicitation was previously presented by the browser client"

Applicants' claimed "accessing" step recites the additional action of reading a timestamp value to determine "a period of time that has passed since the *on-line survey solicitation* was

previously presented by the browser client." The accessing step thus ensures that an unwilling user will not receive repeated *solicitations to take a survey*.

In contrast to the recited "accessing" step, both de Ment and Smith disclose determining whether a user has previously *taken a survey*. Since Smith merely records *completed surveys*, there is no way for Smith's system to determine a time duration since a last *survey solicitation* was submitted to the user computer. Smith thus does not disclose a mechanism that can readily identify a user that has declined a series of previously submitted solicitations to take a survey. Instead, Smith merely prevents users from *taking multiple surveys* of a same type. Similarly, de Ment tracks when a user previously *took a survey* to ensure that at least a period of time passes (6 months) before asking the user to take the survey again. Both Smith and de Ment are directed to limiting *taking a survey* and do not disclose any means for determining when a user was last presented with an *on-line survey solicitation*. This is not unexpected given that both Smith and de Ment are directed to preventing a user from *re-taking a previously completed survey*. **In the event the rejection of claim 1 is not withdrawn, Applicants specifically request identification of a timestamp indicating a period of time that has passed since the "on-line survey solicitation" was previously presented by the browser client (as opposed to when a user last took a survey).**

For this additional reason the combined teachings of Smith and de Ment do not render the claimed invention obvious.

*The recited "executing the additional ... instructions" step*

Applicants' claimed "executing" step is recited as follows:

"executing the additional computer-readable instructions if the timestamp value indicates passage of a period of time satisfying a prescribed wait period between consecutive presentations of the on-line survey solicitation by the browser client on the user computer"

Applicants' claimed "additional computer-readable instructions" are embedded within a downloaded *block of data from an ad server* and "facilitate decision-making steps for determining whether to present an on-line survey solicitation via the browser client." The "executing" step, *properly construed* (i.e., paying proper attention to antecedent basis) in combination with the previously recited "issuing", "providing", and "accessing" steps, requires: (1) sending, within an ad data block from an ad server, additional instructions for determining *whether to present an on-line survey solicitation*, and (2) executing the additional instructions if

a timestamp accessed on the user computer indicates a sufficient period of time has passed since a previous *on-line survey solicitation*.

The Decision does not identify either: (1) a data block sent by an ad server or (2) the recited time stamp identifying a period of time that has passed since an "on-line survey solicitation" was previously presented on the user computer. De Ment instead measures a time period since a last *survey* was presented to a user.

Moreover, de Ment's "decision step 216" does not lead to executing additional instructions embedded within a *data block sent by an ad server*. In fact, neither Smith nor de Ment discloses such instructions being *sent* in a data block from an ad server. The Decision, in upholding the rejection of the independent claims, relied upon a very broad interpretation of the term "providing." See, Decision, page 10, lines 13-18. Applicants have amended the claims, consistent with the disclosure at page 5, lines 22-25 of the original specification, to recite the term "sending" instead of the more general term "providing." Applicants request **in the event the rejection is not withdrawn, identification of a teaching within either Smith or de Ment that such additional instructions are in a data block sent by an ad server.**"

Applicants have identified multiple elements of **claim 1** that are simply not disclosed in either Smith or de Ment. The rejection of **claim 1** as obvious over de Ment in view of Smith should be withdrawn. Applicants seek withdrawal of the rejections of **independent claims 13 and 17 and each of the dependent claims** for at least the reasons provided above with regard to the Decision's new grounds for rejecting independent claim 1.

Additionally, Applicants furthermore specifically traverse the rejection of certain ones of the dependent claims for at least the further reasons set forth herein below.

Applicants traverse the rejection of **claim 6** at page 10 of the Decision since both Smith and de Ment ONLY record *actual completions of surveys*. Neither Smith nor de Ment discloses generating a cookie including the timestamp indicating a *survey solicitation was presented* on the user computer. Smith and de Ment disclose systems that prevent a user from taking the same survey multiple times, but neither reference discloses a need to limit repeated *solicitations to take a survey* or address such need by recording a timestamp indicating when a user was previously solicited to take a survey. For at least this further reason, the claimed subject-matter of claim 6 is not disclosed in either de Ment or Smith.

Applicants traverse the rejection of **claims 7 and 15**. Claims 7 and 15 recite elements relating to "on-line survey solicitations" which are different from actual "surveys" completed by users. Applicants furthermore note that paragraphs [0129-0130] of Smith disclose limiting a "quantity" of surveys taken by a particular user rather than a "frequency" (how often) with which solicitations are presented to a particular user computer. De Ment only stores timestamps for "completed surveys." There is no way for de Ment to track previously presented, but declined, presentations of survey solicitations. As such, there is no way for de Ment to control the frequency of survey solicitations.

Applicants traverse the rejection of **claim 11**. Claim 11 recites additional elements relating to the previously sent "on-line advertisement" from the ad server. The Decision disregards the context of the further recited elements of claim 11. In particular, neither Smith nor de Ment discloses linking the survey questions to a product or service advertised in the on-line advertisement *provided in the block of data sent by the ad server* (as called for in claim 1).

Applicants specifically seek withdrawal of the rejection of **claim 17**. The rejection of claim 17, like the rejection of claim 1, does not distinguish between an initially downloaded web page and a subsequently requested ad block, by a user computer, from an advertisement server.

*2. Rejection of claims 9-10, 21, 23, 24, and 28-32 over de Ment in view of Smith and Winn*

Applicants acknowledge, with appreciation the reversal of the final rejection of **claims 8 and 22** as obvious over Smith in view of de Ment and Winn. Applicants note that **claims 23 and 24** are also allowable since they depend from claim 22. Applicants traverse the rejection of each of the remaining claims for at least the reasons stated herein above regarding the independent claims from which each depends.

Applicants specifically seek reversal of the rejection of claim 32 as obvious over Smith in view of de Ment, Winn and Official Notice. Moreover, Applicants note that their challenge to the FINAL Office Action's assertion of "Official Notice" was *timely*. If anything, the assertion of reliance upon "Official Notice" in the Final Office Action was untimely.

The reliance upon Official Notice was improper since the claimed appending of a random number to a URL in the context of the claimed invention was not notoriously well

known at the time of the invention. As previously conceded by Applicants, URLs are indeed well known. The notoriously well known function of a URL is as a name representing a particular network address (resolved using a naming service). However, nowhere in the cited references is there a suggestion to append the randomly generated value to the portion of the URL identifying the location of the sender of a survey request to the survey logic server that ultimately determines whether to provide the survey to the requesting user computer.

The Final Office Action merely stated that appending a random number to the sender's URL efficiently links the sender to the survey logic server. However, there is no citation to the prior art supporting this bald assertion. There does not appear to be any connection between appending a random number to a URL and efficiently linking a sender to the survey logic server.

Applicants agree that a URL can comprise a series of numbers. However, such teaching does not explain why one skilled in the art at the time of the invention would even contemplate the claimed appending of the random number to the URL. Applicants invite a further explanation, if possible, of the statement "in order to more efficiently gather information from users of the system by defining the goals and objectives of the data to be collected." (See, Answer, page 25, lines 2-3).

#### *Conclusion*

For the above reasons, the above-amended claims are in proper form for allowance. If, in the opinion of the Examiner, a telephone conference would expedite the prosecution of the subject application, the Examiner is invited to call the undersigned attorney.

Respectfully submitted,



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